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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/987,468	12/10/1997	HEINRICH GERS-BARLAG	BEIERSDORF	6313

7590

03/08/2002

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220 EAST 42ND STREET-30TH FLOOR  
NEW YORK, NY 10017

EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	08/987,468	GERS-BARLAG ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Marina Lamm	1616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Acknowledgment is made of the request for reconsideration filed 1/9/02 and certified English language translation of the priority document filed 2/20/02. Claims pending are 12-28.

#### *Double Patenting*

1. The obviousness-type double patenting rejection of Claims 12-28 as being unpatentable over claims 1-20 of U.S. Patent No. 5,876,702 is maintained for the reasons of the record.

#### *Claim Rejections - 35 USC § 103*

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The rejection of Claims 12, 13, 16-21, 24-26 and 28 under 35 U.S.C. 103(a) as being unpatentable over Allard et al. (US 5,616,331) is maintained for the reasons of the record.

4. The rejection of Claims 14, 15, 22, 23 and 27 under 35 U.S.C. 103(a) as being unpatentable over Allard et al. in view of either Billia et al. or Robinson et al. is maintained for the reasons of the record.

5. The rejection of Claims 12-28 under 35 U.S.C. 103(a) as being unpatentable over Gers-Barlag et al. (US 5,725,844) in view of either Grollier et al. (US 5,427,771) or Billia et al. or Robinson et al. is maintained for the reasons of the record.

#### *Response to Arguments*

6. Applicant's arguments filed 1/9/02 have been fully considered but they are not persuasive.

In response to the Applicant's argument that "Allard makes reference to a single sulfonic acid derivative as a sunscreen agent only in passing, and, hence such compounds are

not an essential component of Allard's invention", it is noted that sulfonic acid derivatives such as 2-phenylbenzimidazole-5-sulfonic acid and salts thereof, are explicitly taught by the Allard reference and therefore, are a part of the Allard's invention. The reference's teachings are not limited to the examples or preferred embodiment and must be considered as a whole.

In response to the Applicant's argument that "it was completely surprising and unexpected that the advantageous properties of UV filter substances comprising one or more sulphononic or sulphonate groups could be maximized by including such UV filter substances in the formulations as presently claimed", it is noted that the courts have held that "the arguments of counsel cannot take a place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed.Cir. 1997). Absent a clear showing of unexpected results, the combination of ingredients taught by Allard et al. either alone or in view of either Billia et al. or Robinson et al. is considered obvious.

In response to the Applicant's argument that the Gers-Barlag's ('844) most preferred embodiments utilize monoglyceryl emulsifiers and, therefore, "Gers-Barlag actually leads away from the present invention" which utilizes polyglyceryl emulsifiers, it is noted that it is known in the art to use mono- and diesters of fatty acids (C12-C18) and glycerol or polyglycerol for the same art-recognized purpose, i.e. as emulsifiers in sunscreen compositions. See, for example, Grollier et al. at col. 5, lines 27-39.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

*Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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3/8/02

  
JOSE G. DEES  
SUPERVISORY PATENT EXAMINER